



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Chaitanya Kanojia and Terri Swartz

Application No.: 09/873,785 Group: 2623

Filed: June 4, 2001 Examiner: Bui, Kieu Oanh T.

Confirmation No.: 2842

For: PROMOTIONS ON VIEWING DEVICES

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REMARKS ACCOMPANYING PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

These remarks are being filed with an accompanying Pre-appeal Brief Request for Review in response to the Office Action mailed from the U.S. Patent and Trademark Office on February 6, 2007 in the above-identified application. Please consider these remarks in the requested Pre-appeal Brief Review.

REMARKS

The following is being submitted with a Notice of Appeal under 37 C.F.R. § 41.31 and in support of a Pre-Appeal Brief Request for Review in the above-identified application.

A Final Office Action dated February 6, 2007 rejected claims 1-30, 33-63 and 66-67 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent Number 6,177,931 to Alexander, *et al.*, hereinafter “Alexander” in view of U.S. Patent Pub. 2002/0010928 to Sahota in further view of a U.S. Patent Number 6,615,039 to Eldering.

Applicants believe these rejections of record are clearly not proper and without basis. In support of this position, the below presents clear legal and/or factual deficiencies in the rejections.

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to Applicants’ claimed feature of “the transmission schedule is received as a message which is individually addressed to the network device.” This is clearly recited in the above claims, and the Examiner has failed to show that Eldering discloses this aspect. In addition, the Examiner has also failed to show that this claimed aspect of the present invention is present in either Alexander or Sahota.

More specifically, the Examiner seems to believe that Eldering discloses this aspect of Applicants’ claimed invention as recited in the above claims in Eldering’s FIGS. 1, 2, 10, and in columns 11, line 54 – column 13, line 18. Applicants respectfully disagree.

Eldering’s FIG. 1 merely illustrates that reducing the number of subscribers in a receiving group, from all to some to one, increases the amount of available bandwidth per subscriber. As such, Eldering merely describes that more bandwidth for content is available per subscriber by addressing the content to fewer subscribers.

Applicants, on the other hand, claim a transmission schedule containing control data specifying a condition for activating a promotion and that the transmission schedule is received as a message which is individually addressed to a network device. In this way, a network device receives control data to activate a promotion which is individually addressed to the network device. In other words, transmission schedules are individually addressed so that each network

device may receive, on an individual basis, the data it needs for activating promotions (such as date and time of day).

For example, in a network of 10,000 network devices, regardless of whether there is one condition or 10,000 different conditions for activating a promotion, 10,000 transmission schedules are individually addressed and received by each of the 10,000 network devices.

Accordingly, Applicants respectfully submit that Elderling's addressing of smaller groups of subscribers to increase bandwidth per subscriber is not the same as a transmission schedule is received as a message which is individually addressed to a network device.

Now as for Elderling's FIG. 2 and the corresponding description, Elderling merely describes using a multicast address to form of a group of subscribers interested in receiving the same information (e.g., listening to the same radio station). Elderling, column 5 lines 6 – 26. Applicants respectfully submit Elderling's addressing a broadcast of information with a single multicast address so that every interested subscriber receives the same information is not the same as a transmission schedule is received as a message which is individually addressed to a network device.

Elderling's FIG. 10 merely illustrates a subscriber with an IP address of "Subscriber IP Address" receiving a program with a multicast address of "Program Multicast Address" and receiving an ad with a multicast address of "Ad Multicast Address." As such, Elderling's table in FIG. 10 merely "indicates which multicast subgroups should be formed" (Elderling: 11 lines 55 through 57) and is silent as to a subscriber receiving a transmission schedule (or any other form of non-content) with an address of "Subscriber IP Address." Accordingly, Elderling only describes receiving content addressed to a multicast group. Applicants respectfully submit Elderling's receiving content addressed to a multicast group of subscribers is not the same as a transmission schedule received as a message which is individually addressed to a network device.

In column, line 54 – column, line 18, Elderling describes techniques for sending ads along with programs (in-band transmission) and sending ads separately from programs (out-of-band transmission). Elderling further describes that with these techniques, regardless of whether ads and programs are sent together or separately, the ads and/or programs are addressed to a group of subscribers using a single multicast address. *See e.g.*, Elderling, column 11, line 66 – column 12,

line 4 (advertisements are directed according to the advertisement multicast addresses); column 12, lines 7-11 (presentation streams are directly transmitted to a group of subscribers); column 12, lines 11-14 (multicast a presentation stream to subscribers in a multicast subgroup); and column 12, lines 33-39 (programming is transmitted on one multicast channel to a first group of subscribers, and one or more advertisements are transmitted on a second multicast channel to a second group of subscribers).

The remainder of Eldering merely describes the type of content (“programming or entertainment program streams include digital video or audio streams that contain programming of interest to the subscriber”), the compression of the content (motion pictures expert group (MPEG) compression standard and REALAUDIO), and the substitution and insertion of the content (“generic/default advertisements are substituted with one or more targeted advertisements,” and “one or more target advertisements are inserted in these ad breaks”). Eldering, column 12, line 55 – column 13 line 18).

Applicants respectfully submit Eldering’s sending ads and programs, together or separately, addressed to a group of subscribers using a single multicast address is not the same as a transmission schedule is received as message which is individually addressed to a network device.

CONCLUSION

According to the forgoing, it is respectfully requested that the panel find:

(i) that all existing claims are in condition for allowance and that the application should pass to issue,

or in the alternative,

(ii) that prosecution on the merits of the case should be reopened with an appropriate Office communication.

If a telephone conference would expedite prosecution of this case, the undersigned may be reached at (978) 341-0036.

Respectfully submitted,

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

By 

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

2657.2006-001

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on 5/7/07Signature Angelina BellantonTyped or printed name Angelina Bellanton

Application Number

09/873,785

Filed

June 4, 2001

First Named Inventor

Chaitanya Kanojia

Art Unit

2623

Examiner

Bui, Kieu Oanh T.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

 applicant/inventor.

Signature

 assignee of record of the entire interest.David J. Thibodeau, Jr.See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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 attorney or agent acting under 37 CFR 1.34.5/7/07

Date

Registration number if acting under 37 CFR 1.34

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of 1 forms are submitted.

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